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09/175,156	10/19/1998	KEITH LYNN PUTNAM	2454.1129	6575
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER PHAN, JOSEPH T	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/175,156

Applicant(s)

PUTNAM ET AL.

Examiner

JOSEPH T. PHAN

Art Unit

2614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered and new allowable subject matter has been indicated.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the called party is provided with messaging options before the called party answers the telephone) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is noted the claims only recite the 'incoming call is pending' and whether before or after, Robinson's call is pending when dialed. Therefore, the examiner maintains the rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 21-22 and 26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 line 2 recites "...activating a user command interface for predetermining period of time..." which is unclear and confusing if this refers to 'determining a period of time' or if a "predetermined period of time" has already been indicated.

Claim 21 recites "the incoming call is not yet connected" which is contradictory to the

parent claim 10 of "while the incoming call is pending" which insinuates that the call is already connected/established.

Claims 22 and 26 recites "itself" which is unclear and confusing as it is not know what is being referred to.

Appropriate clarification and/or correction is required.

Allowable Subject Matter

3. Claim 6 is allowed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-27 rejected under 35 U.S.C. 102(b) as being anticipated by

Robinson, Patent #6,219,413.

Regarding claims 1 and 5, Robinson teaches a system for responding to an incoming phone call from a calling party, comprising:
means for receiving the incoming phone call(10 Fig.1 and Fig.6); means for generating a user alert in response to the incoming phone call, said generating means including a ring signal detection means(16 and 20 Fig.1 and Fig.6); means at a called party's telephone for enabling selective entry of a user message in response to the alert while the incoming call is pending and still ringing to the calling party(20-28 Fig.1 and Fig.6); and
means for playing the user message to the calling party(64 Fig.1, 112 Fig.4, and Fig.6), said

playing means including means for transmitting said user message from the called party telephone to the calling party telephone via the telephone network(Fig.1 and Fig.6); and timing means responsive to the ring signal detection means for timing a predetermined period during which a called party can select to generate the user message(col.4 lines 41-67); wherein the selective entry means includes means for selecting between recording one or more parameters insertable in a customized pre-recorded message(col.6 lines 110-27) and recording a message without parameters while the incoming call is pending(col.4 lines 62-67 and col.6 lines 10-27); wherein the receiving means includes a voice recognition unit for recognizing at least one spoken command(150 Fig.5, Fig.6, and col.6 lines 13-27);

wherein the at least one spoken command includes a predetermined instruction and a variable parameter(col.6 lines 13-27; *new greeting to caller*).

Regarding claim 2, Robinson teaches the system of claim 1, further comprising means for releasing the call after playing the message(Fig.4, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 3, Robinson teaches the system of claim 1, further comprising means for displaying caller identification information to the user(Fig.1, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 4, Robinson teaches the system of claim 1, wherein the receiving means includes means for activating a user command interface for predetermining period of time following commencement of the user alert(Fig.1, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 7, Robinson teaches the system of claim 1, wherein the receiving means includes means for manually selecting the user message(Fig.1, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 8, Robinson teaches the system of claim 1, wherein the means for receiving includes means for recording an audio user message(Fig.1, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 9, Robinson teaches the system of claim 1, wherein the means for receiving includes means for storing the user message(Fig.1, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 10, Robinson teaches a telephony device for playing a customized message to a caller, comprising:
a ring detector generating a detection signal in response to an incoming telephone call(Fig.1 and 6), a ringer alerting a called party to the incoming call in response to the detection signal(Fig.1, col.4 lines 60-67 and col.6 lines 13-27); a command interface for receiving one or more message parameters from the called party(Fig.6 and col.6 lines 8-27); and
a controller for activating the command interface in response to the detection signal and for transferring the customized message to the caller, wherein the controller is an element of the telephone, the customized message being transferred from the telephony device via the telephone network wherein the controller is configured to selectively either record the customized message while the incoming call is pending or receive one or more parameters in a pre-recorded message while the incoming call pending(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);
wherein the telephony device can respond to the incoming telephone call by answering the call, transferring the customized message and releasing the call or can accept the call by going off hook(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);

Regarding claim 11, Robinson teaches the telephony device of claim 10, further

comprising:

a voice recognition unit for receiving spoken commands that include the message parameters(Fig.1 and 6, and col.6 lines 13-27);

Regarding claim 12, Robinson teaches the telephony device of claim 10, further comprising: an audio interface for receiving a spoken message from the called party(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);

Regarding claim 13, Robinson teaches the telephony device of claim 12, further comprising: a memory for storing the spoken message(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);

Regarding claim 14, Robinson teaches the telephony device of claim 10, further comprising: a key pad permitting the called party to manually enter the message parameters(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);

Regarding claim 15, Robinson teaches the telephony device of claim 10, further comprising:
a caller identification unit for displaying caller information to the called party(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);

Regarding claim 16, Robinson teaches A method for presenting an audio message to a telephone caller, comprising:
detecting, at a recipient telephone, ringing signaling an incoming telephone call(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27);
generating, from the recipient telephone, a user alert in response to the incoming telephone call ringing signaling, based on the incoming phone call itself(Fig.1 and 6, col.4 lines 60-67 and col.6

lines 13-27);

receiving a command from a called party in response to the user alert(fig.1); generating from the recipient telephone, an audio message based on the command while the incoming call is pending, wherein the generating includes providing an option of recording an outgoing message or recording one or more parameters insertable into a pre-recorded message answering the incoming call; and playing the audio message to the telephone caller over the telephone network(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 17, Robinson teaches the method of claim 16, further comprising: activating a voice recognition unit to receive the command(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 18, Robinson teaches the method of claim 16, further comprising: recording a spoken message from the called party and including the spoken message in the audio message(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 19, Robinson teaches the method of claim 16, further comprising: manually entering the command using a keypad(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 20, Robinson teaches the system of claim 1, wherein the system is incorporated within a telephone(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 21, Robinson teaches the telephony device of claim 10, wherein the command interface receives the one or more message parameters from the called party while the incoming call is not yet connected(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 22, Robinson teaches the telephony device of claim 10, wherein the ring

detector is configured to detect the incoming phone call based on the incoming phone call itself(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 23, Robinson teaches the telephony device of claim 22, wherein the ring detector is configured to detect a ring signal of the incoming telephone call(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 24, Robinson teaches the method of claim 16, wherein the detecting step detects the incoming telephone call by detecting a ring signal of the incoming telephone call(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 25, Robinson teaches the system of claim 1, wherein said means for playing the user message to the calling party is configured to cause playing the user message to the calling party in some instances in which the user refuses to answer the incoming phone call(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 26, Robinson teaches the system of claim 1, wherein the means for generating a user alert in response to the incoming phone call comprises means for detecting the incoming phone call based on the incoming phone call itself(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Regarding claim 27, Robinson teaches the system of claim 26, wherein the means for detecting the incoming phone call comprises means for detecting a ring signal of the incoming telephone call(Fig.1 and 6, col.4 lines 60-67 and col.6 lines 13-27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH T. PHAN whose telephone number is (571)272-7544. The examiner can normally be reached on Mon-Fri 9am-6:30pm EST, off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph T Phan/
Examiner, Art Unit 2614